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K&L Gates LLP				
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CHICAGO, IL 60690				
EXAMINER				
RENWICK, REGINALD A				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/539,848

**Applicant(s)**

MILES ET AL.

**Examiner**

REGINALD A. RENWICK

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05/07/2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-57 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In response to the amendment filed 05/07/2009. Claims 1-56 and the newly added 57 are pending.

***Claim Objections***

2. Claim 13 is objected to because of the following informalities: the claim language states dependence on claim 14. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-24, 26-44, 47, 48, 50-52, and 55-57 rejected under 35 U.S.C. 102(b) as being anticipated by Cole et al. U.S. PG PUB 2001/0054794).

Re claims 1, 18, and 20: Cole discloses. a gaming device (0034: gaming device) comprising:

at least one display device (Fig.1, object 27 and its contents & 0040: display);

at least one input device (Fig. 1, object 26: pull arm);

at least one processor (0045: processor); and

at least one memory device (0045: memory device) which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input (Fig. 1A & 0055: pull arm and other input devices); device to:

a.) display a primary game including a plurality of reels having a plurality of symbols, at least one of said symbols including a modifier activator symbol (0092: the modifier activator symbols are winning combinations that trigger a winning amount to be paid and associated with the bonus reel. If the player did not win any games by achieving these specific combinations then the player can not play bonus reel game);

b.) activate the reels and display at least one of said symbols (0092: the player plays a slot machine game);

(c) provide any award based on the at least one displayed symbol (0093: the player is awarded for any amount associated with the combination);

d.) determine whether the modifier activator symbol is displayed on the reels (the game occurrence in Fig. 3B & 0092: the player is awarded a game modifier symbol when a predetermined combination is displayed on the reels and thus any symbol can be a modifier activator symbol);

e.) in response to the display of the modifier activator symbol, display a plurality of different modifiers (0057 & 0092: while under the situation presented in Fig.3b, the player can select a "win all" or "10" modifier, the player can also select a multiplier modifier from an additional bonus reel as described in 0057);

f.) after the plurality of different modifiers are displayed, receive an input from a player, the input corresponding to a selection of one of the displayed plurality of modifiers (0101: the player can then select one or all of the modifiers to save for use in later games);

g.) after the selection reactivate the reels one or more times (0101: the player can start a new game and reactivate the reels with the imported bonus modifiers from the card).

h.) apply the selected modifier to modify at least one function of the primary game for each one of the reactivations of the reels (101: the modifier can be applied to the new primary game to modify an award amount); and

i.) in response to a winning outcome for at least one of the reactivations, provide an additional award based, at least in part on the at least one modified function of the primary game (0092 & 0101: after being reinserted into the bonus reel, the bonus reel can award additional amount to the primary wagering game based on the bonus modifier).

Re claims 2 and 21: Cole discloses with respect to the gaming device of claim 1, wherein a plurality of said symbols are modifier activator symbols (0092: because any of the symbols can be a modifier activator symbol when in a specific combination, therefore the game machine has a plurality of symbols that are modifier activator symbols)

Re claims 3 and 22: Cole discloses with respect to the gaming device of claim 1, the instructions including a plurality of instructions executable to receive a signal corresponding to the input from the player in response to a plurality of modifier activator symbols being displayed (0055 & 0101: the player can input a plurality of modifier selections into a touch screen device).

Re claims 4 and 23: Cole discloses with respect to the gaming device of claim 1, the instructions including a plurality of instructions executable to receive a signal corresponding to a second input from the player, the second input corresponding to a selection of a second one of the displayed plurality of modifiers (0055 & 0101: the player can input a plurality of modifier selections into a touch screen device).

Re claim 5 and 24: Cole discloses with respect to the gaming device of claim 1, the instructions including a plurality of instructions executable to cause the at least one processor to apply a plurality of selected modifiers to modify a plurality of functions of the primary game (0092: the award amounts associated with each winning combination is changed to that of the bonus award).

Re claim 7 and 26: Cole discloses with respect to the gaming device of claim 1, the instructions including a plurality of instructions executable to receive a signal corresponding to input from the player if said modifier activator symbol is displayed and no modifiers are currently activated. (Fig. 3B: in this game situation there are no

modifiers currently selected until the player makes an input using the pull-arm to determine that enables the play to spin the reels. Applicant states that the signal corresponds to "input" and not specifically to the input of claim one. Thus the invention meets the claim language stated)

Re claims 8 and 27: Cole discloses with respect to the gaming device of claim 1, which includes a modifier generator displayed to the player that includes said plurality of modifiers (Fig. 3A, object 40: the modifier generator is the game machine itself as it displays to the user a plurality of modifiers in the bonus reel, 40).

Re claims 9 and 28: Cole discloses with respect to the gaming device of claim 8, the instructions including a plurality of instructions executable to cause the at least one processor to operate with the modifier generator to receive a signal corresponding to the input from the player, the input corresponding to the selection of at least one of the plurality of modifiers. (0055 & 0101: the player can input a plurality of modifier selections into a touch screen device).

Re claim 10 and 29: Cole discloses with respect to the gaming device of claim 8, wherein said instructions include a plurality of instructions executable to cause the at least one processor to operate with the modifier generator to receive a signal corresponding to the input from the player if no modifiers are currently activated (0055 & 0101: because none of the modifiers are active until they are selected through the

spinning of the bonus reel, the modifier receives input identifying a modifier to be inputted into the game while no modifier is active)

Re claim 11 and 30: Cole discloses with respect to the gaming device of claim 9, wherein said selected modifiers is activated if said modifier activator symbol is displayed. (0055: the modifier is activated when placed into the modifier reel).

Re claim 12 and 31: Cole discloses with respect to the gaming device of claim 8, wherein said instructions include a plurality of instructions executable to cause the at least one processor to operate with the modifier generator to receive a signal corresponding to another input from the player, the another input corresponding to another selection of one of the displayed plurality of modifiers. (0101: The player can save multiple modifiers).

Re claims 13 and 32: Cole discloses with respect to the gaming device of claim 14, said modifier generator being configured to spin if the at least one modifier is not displayed on the reels (0046: the player can spin the bonus reel at anytime).

Re claims 14 and 33: Cole discloses with respect to the gaming device of claim 8, wherein said modifier generator includes a modifier reel.



Re claims 15 and 34: Cole discloses with respect to the gaming device of claim 1, the instructions including a plurality of instructions executable to cause the at least one processor to enable the player to select a plurality of the modifiers (0101: The player can save multiple modifiers).

Re claims 16 and 35: : Cole discloses with respect to the gaming device of claim 1, wherein each modifier is associated with the same plurality of subsequent activations of the reels (in relation to Cole this limitation is dependent on the player's actions during the game as the player can choose to play each modifier they have won every).

Re claim 17 and 36: Cole discloses with respect to the gaming device of claim 1, wherein a plurality of said modifiers are each associated with a different plurality of subsequent activations of the reels. (Because each modifier's placement in the bonus reel is determined at a particular time associated with a winning combination, each modifier while in the bonus reel is operable for a different plurality of subsequent activations of the reels).

Re claim 19: Cole discloses with respect to the gaming device of claim 18, wherein the triggering event is the player making a wager on the primary wagering game (0012: the player places a wager in the primary wagering game).

Re claim 37: Cole discloses a gaming system comprising: at least one display device; at least one input device; at least one processor; and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input device to:

- (a) receive an input based on a wager (Fig. 1, object 26 & 0038: pull arm);
- (b) operate a first play of a primary game, the primary game having a plurality of reels, the reels having a plurality of symbols, the symbols having at least one modifier symbol, at least one of the symbols being associated with a winning condition (0009: a slot machine game);
- (c) generate a plurality of the symbols (0009: a slot machine game displaying game indicia);
- (d) provide an award as a result of the winning condition being satisfied (0093: the player is awarded for any amount associated with the combination);
- (e) in response to the generated symbols including the at least one modifier symbol, activate a modifier generator, the modifier generator displaying a plurality of modifiers (the game occurrence in Fig. 3B & 0092: the player is awarded a game modifier symbol when a predetermined combination is displayed on the reels and thus any symbol can be a modifier activator symbol);
- (f) after the display of the plurality of modifiers, receive an input from a player, the input corresponding to a selection of one of the displayed plurality of modifiers (0101: the player can then select one or all of the modifiers for use in later games);

- (g) after the selection, operate a second play of the primary game (101: the modifier can be applied to the new primary game to modify an award amount);
- (h) modify for the second play, based on the selected modifier, at least one of: (i) the award, if any (0092 & 0101: after being reinserted into the bonus reel, the bonus reel can award additional amount to the primary wagering game); and
- (i) in response to a winning outcome for the second play of the primary game, provide an additional award, the additional award being based, at least in part, on the modification of step (h) (0092 & 0101: after being reinserted into the bonus reel, the bonus reel can award additional amount to the primary wagering game).

Re claim 38 and 47: Cole discloses a method of operating a gaming device, said method comprising:

- (a) displaying a game including a plurality of reels, wherein each of said reels includes a plurality of symbols including a modifier activator symbol (0092: the modifier activator symbols are winning combinations that trigger a winning amount to be paid and associated with the bonus reel. If the player did not win any games by achieving these specific combinations then the player can not play bonus reel game. This also pertains to claim 47);
- (b) activating said plurality of reels (0092: the player plays a slot machine game);;
- (c) providing a player any award based on the symbols displayed on the reels after said activation (0093: the player is awarded for any amount associated with the combination);

(d) in response to the display of the modifier activator symbol, displaying a plurality of different modifiers, wherein each of said modifiers is associated with a quantity of subsequent activations of the reels, the quantity being at least one (0057 & 0092: while under the situation presented in Fig.3b, the player can select a "win all" or "10" modifier, the player can also select a multiplier modifier from an additional bonus reel as described in 0057);

(e) after the display of the plurality of modifier activator symbol, receiving an input from the player, the input corresponding to a selection of one of the displayed plurality of modifiers (0101: the player can then select one or all of the modifiers to save for use in later games),

(f) repeating steps (b) to (c) at least the quantity of times, wherein at least one function of the game is modified based on the selected modifier (101: the modifier can be applied to the new primary game to modify an award amount); and

(g) for each of the subsequent activations of the reels, providing the player an outcome, the outcome being based on, at least in part, the modification of the function of the game (0092 & 0101: after being reinserted into the bonus reel, the bonus reel can award additional amount to the primary wagering game based on the bonus modifier)..

Re claim 39: Cole discloses with respect to the method of claim 38, wherein a plurality of said symbols are modifier activator symbols (0092: because any of the symbols can be a modifier activator symbol when in a specific combination, therefore the game

machine has a plurality of symbols that are modifier activator symbols).

Re claim 41: Cole discloses with respect to the method of claim 38, which includes enabling the player to select a plurality of said modifiers (0055 & 0101: the player can input a plurality of modifier selections into a touch screen device).

Re claim 42 and 51: Cole discloses with respect to the method of claim 38, wherein each modifier is associated with the same plurality of subsequent activations of the reels (in relation to Cole this limitation is dependent on the player's actions during the game as the player can choose to play each modifier they have won every).

Re claim 43 and 52: Cole discloses with respect to the method of claim 38, wherein a plurality of said modifiers are each associated with a different plurality of subsequent activations of the reels (Because each modifier's placement in the bonus reel is determined at a particular time associated with a winning combination, each modifier while in the bonus reel is operable for a different plurality of subsequent activations of the reels).

Re claim 44: Cole discloses with respect to the method of claim 38, wherein more than one modifier is activated for at least one subsequent activation of the reels (0092: the player may choose when to play the activated modifier, and thus the modifiers may be

activated for multiple activations of the reels).

Re claim 48: Cole discloses with respect to the method of claim 47, wherein at least one of the plurality of modifiers is selected if the player obtains at least one modifier activator in one of the subsequent plays of the primary wagering game. (0092: whenever a player achieves a winning combination the modifier associated with the particular combination can be applied to the modifier reel).

Re claim 50: Cole discloses with respect to the method of claim 47, wherein the player is enabled to select a plurality of the modifiers (0055 & 0101: the player can input a plurality of modifier selections into a touch screen device)..

Re claims 55 and 56: Cole discloses with respect to the gaming device of claim 37, wherein the at least one function includes at least one primary game outcome (0092 & 0101: the player can modify the game award of the primary game as an award is a game outcome which also relates to claim 56).

Re claim 57: Cole discloses with respect to the gaming device of claim 1, wherein the instructions include a plurality of instructions executable to cause the at least one processor to operate with the at least one display device to, for at least one of the reactivated reels: (b) for the at least one activated payline: (i) apply the selected modify to at least one function of at least one symbol indicated by the payline; and (ii)

determine the additional award based on the modified function (0092 & Fig. 3A: the middle payline is the default activated payline for the primary game, and if the player imports their saved modifier into the primary game, the player can modify the payline award with the selected modifier).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 25, 40, 45, 46, 49, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Barrie (U.S. Patent No. 5,833,537).

Re claims 6, 25, 40, and 49: Cole discloses the invention significantly but fails to disclose with respect to the gaming device of claim 1, which includes an active modifier counter associated with each of the modifiers, said active modifier counter being operable to indicate any currently selected modifier and a/the plurality of remaining subsequent activations of the reels that the modifier will be selected. However, like the instant application which encourages play within a specific time period, the game of Barrie also encourages play by limiting the time in which a bonus multiplier can be played in the primary game. Particularly, Barrie discloses that each multiplier has a specific number of spins associated with the multiplier in which an internal counter

monitors the number of spins (column 5, lines 5-7). Furthermore, Barrie discloses a method of informing players of the length of an active persistent symbol (column 5, lines 19-26). Although, Barrie does not specifically disclose a counter, a counter would support this method of informing players of the length of an active persistent symbol. It would have been obvious to one skilled in the art to modify the invention of Cole with a timer for the purpose of encouraging players to play more game rounds.

Re claims 45, 46, 53, and 54: Cole discloses the invention substantially but fails to disclose with respect to the method of claim 38, which is provided to the player through a data network wherein the network is an internet. However, Barrie discloses a game machine that can be played through a data network wherein the network is the Internet (column 4, lines 56-60). It would have been obvious to modify the game machine of Cole with the network features of Barrie for the purpose of providing upgrades to the game machine easier.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection. The Applicant has heavily amended the claims to overcome the prior art of Barrie, and because Cole has been identified as new art pertaining to the instant application, a new rejection based on new grounds has been made.



***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD A. RENWICK whose telephone number is (571)270-1913. The examiner can normally be reached on Monday-Friday, 7:30AM-5:00PM, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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